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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/390,846 09/14/99 KOK

J I/95150-US/D

EXAMINER

HM12/0515

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FIELDS, I

ART UNIT

PAPER NUMBER

1645

DATE MAILED:

05/15/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

09/390,846

Applicant(s)

KOK ET AL.

Examiner

Iesha P Fields

Art Unit

1645

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☐ Claim(s) 1-25 is/are pending in the application.
- 4a) Of the above claim(s) 4-10, 12, 14, 15, 21, 22 and 25 is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-3, 11, 13, 16-20, and 23-24 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claims ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- 15) ☒ Notice of References Cited (PTO-892)
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____.
- 18) ☐ Interview Summary (PTO-413) Paper No(s). ____.
- 19) ☐ Notice of Informal Patent Application (PTO-152)
- 20) ☐ Other:

DETAILED ACTION

Applicant's amendment received February 21, 2001(Paper No. 6) has been received and entered. Claims 1, 3 and 11 were amended, new claims 16-25, were added, consequently claims 1-25 are pending in the instant application.

Election/Restrictions

1. Claims 1-15 were previously subjected to a restriction requirement, as set forth in the Office Action (Paper No. 3) mailed September 5, 2000. Applicant's elected with traverse Group I claims 1-3 on October 2, 2000 (Paper No.4). A topographical error was made by the Examiner in Office Action (Paper No. 5) which states "that a search of the prior art to Group I would not reveal prior art of Groups II-X" and refers to "Claims 1-42". The Examiner's response to the traversal of the Restriction Requirement in the Office Action was intended to be directed towards Groups II-III and pertains to Claims 1-15. Applicants stated as grounds for traversal that the elected claims 1-3 directed to antigenic determinants of Eimeria lactate dehydrogenase and claims 11, 13 and 15 of Groups II directed to vaccines comprising such proteins cover closely related and overlapping art. Applicant's traversal is persuasive for the recombining of Group I and Group II. Therefore, claims 1-3, and claims 11,13, 16-20, and 23-24 are examined together in this office action

Newly submitted claims 21-22, and 25 are directed to an invention that is independent or distinct from the invention originally claimed. In addition to the previous restriction requirement because Claim 22 is drawn to an antibody, classified in class 530, subclass 388.6 and Claims 21 and 25 are drawn to a method of treatment, classified in class 424, subclass 234.1.

The inventions are distinct, each from the other because:

Inventions III and IV are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the antibody could be used in diagnostic assays.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 21-22 and 25 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

Response to Amendment

Claim Rejections - 35 USC § 112

2. The rejection of the instant application as not being in compliance with the sequence requirements is **withdrawn** in view of Applicant's compliance with the Sequence Requirements.
3. The rejection of claim 3 under 35 U.S.C. 112, second paragraph, as being vague and infinite in recitation of "biologically functional equivalent" is **withdrawn** in view of Applicant's amendment to the claim.
4. The rejection of claims 1-3 under 35 U.S.C. 102(b) as being anticipated by Wisner et al. is **withdrawn** in view of Applicant's arguments.

New Grounds for Rejection

The text of those sections of Title 35 U.S. Code not included in this action can be found in a prior Office Action.

Claim Rejections - 35 USC § 102

5. Claims 1-3 and 11, 13, 16-20 and 23-24 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Binger et al.

The claims are drawn to an immunogenic Eimeria schizont protein.

Binger et al. (US Patent 5,661,015) disclose several immunogenic Eimeria proteins including an Eimeria schizont protein which has a molecular weight of about 37 kilodaltons (See Description of the Invention; Especially Section 5.1). Binger et al. further disclose that the Eimeria antigen is present in the sporozoite, merozoite, and the schizont developmental stages of the parasite. Binger et al. further disclose that the proteins may be used to make a vaccine preparation. Binger et al. further disclose within the scope of the invention are "functionally equivalents" which are defined by Binger et al. as amino acid substitutions and/or deletions which do not alter biological and immunological activity (See Description of the Invention; Especially Definitions Section). The Eimeria protein claimed by the Applicant is being viewed as an obvious functional equivalent and therefore anticipated by the prior art.

Status of Claims

6. All claims stand rejected.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Iesha P Fields whose telephone number is (703) 605-1208. The examiner can normally be reached on 7am-3:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lynette Smith can be reached on (703) 308-3909. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 305-3014 for regular communications and (703) 308-4242 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0196.

Iesha Fields

May 14, 2001


MARK NAVARRO
PRIMARY EXAMINER